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OFFICE OF PETITIONS

In re Patent No.: 6,550,701
Issue Date: April 22, 2003
Application No. 09/684,777
Filed: October 10, 2000
Inventor: Chang

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: DECISION ON PETITION
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This is a decision on the petition under 37 CFR 1.182 filed April 19, 2005, which is properly treated as a petition under 37 CFR 1.181(a)(3) asking the Director to exercise his supervisory authority and review the refusal of Certificate of Correction Branch mailed March 2005 to issue the requested Certificate of Correction.

The petition is **DENIED**.

BACKGROUND

The above-identified patent, as filed October 10, 2000, contained 4 claims, with claim 1 being the sole independent claim. Claim 1 provided:

A dual-functional medium shredding machine structure, that allows shredding of paper, optical discs, and credit cards, characterized in comprising: a machine body being provided with a power switch on a surface thereof and roller blades therein, the roller blades being driven by a gearbox; two inports on an upper lid thereof, the inports including a paper inport with an opening of a larger dimension and inclined, curved channel walls, and a disc inport with an opening of a smaller dimension and vertical channel walls, the inports being each led to the shredding roller blades such that, regardless of the type of substance being fed by a user, the paper or the disc can all be shredded by the shredding roller blades through the intermeshing of roller blades; a paper touch switch being provided at an appropriate location between the paper inport and the roller blades; and a disc touch switch being provided at an appropriate location between the paper inport and the roller blades; whereby the roller blades are activated by the touch switches when paper, discs, or credit cards are fed and touch the touch switches so as to activate the roller blades to perform intermeshing and shredding task.

Claim 4 depends from independent claim 1, and provided:

The dual-functional medium shredding machine structure of claim 1, wherein the paper inport and the disc or card inport are both led to the roller blades, a single touch switch is provided between the roller blades such that regardless of the type of substance being fed by a user, the paper, disc, or credit cards can all touch the touch switch so as to activate the roller blades to perform shredding task while the scraps are all dispensed to an identical bin.

Thus, independent claim 1 called for a paper touch switch located "between the paper import and the roller blades" and a disc touch switch also located "between the paper import and the roller blades." Dependent claim 4 references independent claim 1 and further recites a single touch switch which is "provided between the roller blades."

On November 14, 2002, the examiner allowed claims 1-4 exactly as they had been drafted by applicant and presented on filing.

The patent issued on April 22, 2003, with claims 1-4 printed exactly as allowed by the examiner, *i.e.*, exactly as they had been drafted by applicant and presented on filing.

A request under 37 CFR 1.322 for a Certificate of Correction was filed October 20, 2004. The request asserted that the Office had erred during examination by failing to require that applicant rewrite claim 4 as an independent claim. That is, the requested correction contended that as claim 1 recited two touch switches, and claim 4 specified but one touch switch, claim 4 is broader in scope than claim 1, and therefore could not be considered a claim properly dependent on claim 1.

On or about March 5, 2005, Certificates of Correction Branch refused the requested correction as not falling under 35 U.S.C. § 254 and 37 CFR 1.322, based upon the examiner's determination. Rather, reissue was suggested as the avenue for obtaining the requested relief.

The instant petition was filed April 19, 2005.

On April 20, 2005, petitioner filed a request for reissue of the above-captioned patent, which was assigned application no. 11/109,843. The filing was announced in the Official Gazette of November 8, 2005.

On March 7, 2006, the court in Michilin Prosperity Co. v. Fellowes Mfg. Co., 422 F.Supp.2d 86 (D.D.C. Mar. 7, 2006) rendered a decision in litigation involving the above-captioned patent. The court, *inter alia*, declined to correct the patent by rewriting claim 4 in independent form as beyond its corrective power, and in so doing opined that the underlying error was caused by applicant and was not caused by the USPTO. *Id.* at 91 ("Michilin requests that this court correct a drafting error by the patent applicant.").

OPINION

37 CFR 1.182, by its terms applies when no other regulation speaks to the issue. Since 37 CFR 1.181(a)(3) provides for the requested supervisory review, 37 CFR 1.182 is inapposite. In any event, petitioner requests reconsideration of the refusal of Certificates of Correction Branch to issue the requested correction that seeks to rewrite claim 4 in independent form. Petitioner again asserts that claim 4, which Petitioner drafted and presented to the Office, was an improper dependent claim and as such, the Office should have required claim 4 to be rewritten in independent form.

Since petitioner has failed to show that the issues herein raised are proper subject matter for a Certificate of Correction under either 35 U.S.C. § 254 (or § 255), the refusal of Certificate of Correction Branch to process the requested correction will not be disturbed.

As to § 254 and its promulgating regulation, 37 CFR 1.322:

This or any patent is printed in accordance with the record in the Patent and Trademark Office of the application as passed to issue by the examiner. In order for a proposed correction to lie under § 254 and its promulgating regulation, the requestor must show that (1) there is a mistake in the patent, that was (2) incurred through the fault of the Patent and Trademark Office, which mistake is (3) clearly disclosed by the records of the Office.¹ See 35 U.S.C. §

¹ It is noted that a Certificate of Correction is only applicable to causes of action initiated after the USPTO grants the correction. Southwest Software v. Harlequin, 226 F.3d 1280, 56 USPQ2d 1161 (Fed. Cir. 2000). Otherwise, the patent is read in its as-issued, uncorrected form. *Id.*

254.² If any one of the three prongs is not satisfied, then, as here, the Office must deny the request for correction under § 254.

Petitioner contends that a mistake incurred through the fault of the USPTO in that the examiner failed to require that original claim 4 be rewritten in independent claim format. In essence, Petitioner believes that the examiner made a mistake by not catching applicant's claim drafting error and identifying the error in the record. Petitioner asserts that there are two alternate embodiments of the shredder disclosed in the specification: a two switch two bin arrangement, and a one switch one bin. While claim 1 is asserted to refer to the former embodiment, claim 4 is asserted to be drawn to the latter. Petitioner further contends that claim 4 does not present a further limitation to claim 1; rather, claim 4 is contended to remove a limitation, and, as such, is alleged to be an improper dependent claim. Specifically, Petitioner wishes to have the Office rewrite claim 4 to include the limitations of claim 1, except for (i) the "paper touch switch" limitation, (ii) the "disc touch switch" limitation, and (iii) the "whereby the rollerblades are activated by the touch switches" limitation. Petitioner further asserts that the statute, 35 U.S.C. § 112, paragraph 4 defines what is the proper scope of a dependent claim, and MPEP 608.01(n) which addresses the instant circumstance, indicates that the examiner should have required claim 4 to be written in independent form.

Taking the last issue first, inspection of the record of this file fails to "clearly disclose" that the examiner made an error by not requiring claim 4 to be rewritten in independent form. The introductory phrase of the part of section 608.01(n) quoted in the petition sets forth that "[w]here a claim in dependent form is not considered to be a proper dependent claim under 37 CFR 1.75(c), the examiner should object to such claim under 37 CFR 1.75(c) and require cancellation of such improper dependent claim and or rewriting of such improper dependent claim in independent form."

MPEP 608.01(n) subsection III sets forth the test:

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim. A dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope.

Inspection of claim 4 fails to reveal that it is an improper dependent claim. A fair reading of claim 4 as drafted by petitioner and as it appears in the issued patent fails to evidence that claim 4 expressly omits or precludes either or both of the paper touch switch and the disc touch switch, or expressly states that either or both of paper touch switch and the disc touch switch are replaced by the single touch switch. Accordingly, claim 4 meets the test for a proper dependent claim.³ This is particularly so in that in claim 1, the paper touch switch is provided at an appropriate location between the paper inport and the roller blades, and the disc touch

²The USPTO has a long history of issuing certificates of correction to correct errors in patents arising from its processing and patent printing operations that actually predates the statutory authorization provided by § 254 and its 1925 predecessor statute. See McCrady, *Patent Office Practice*, 4th Ed. (1959) at 439. The USPTO originated mistakes in printed patents corrected by Certificates of Correction have run the gamut from the trivial, such as punctuation errors, to omitted drawings, and even to missing claims. *Id.* Here, however, every claim presented on filing by applicant was printed *verbatim* in the as-issued patent.

³ As the court observed in Chef America Inc. v. Lamb-Weston Inc., 358 F.3d 1371, 1374 (Fed. Cir. 2004) "[t]hus, in accord with our settled practice we construe the claim as written, not as the patentees wish they had written it."

switch is likewise provided at an appropriate location between the paper inport and the roller blades; the disc touch switch is not, as claimed, placed between the disc inport and the roller blades. The "single touch switch" of claim 4 is provided at a different location, i.e., "between the roller blades" such that regardless of the respective substance input port used, all substances input can touch the touch switch of claim 4.

Petitioner's further reliance on § 608.01(n) to urge that given a claimed combination of ABCD, a dependent claim omitting D or replacing D with E to show that claim 4 is not a proper dependent claim, is not convincing. A fair reading of claim 4 as drafted by petitioner and as it appears in the issued patent fails to evidence that claim 4 expressly omits or precludes either or both of the paper touch switch and the disc touch switch, or expressly states that either or both of paper touch switch and the disc touch switch are replaced by the single touch switch. While petitioner contends that the specification only describes either a one or two switch embodiment, he has failed to consider the import of the description of claim 4 *vis-a-vis* its being an originally presented claim. An originally filed claim constitutes its own description for purposes of 35 U.S.C. § 112 first paragraph. See *In re Benno*, 768 F.2d 1340, 226 USPQ 683 (Fed. Cir. 1985). Thus, it is permissible for original claims to disclose an embodiment not disclosed in the descriptive part of the patent application, since the original claims are part of the patent specification. See *Hyatt v. Boone*, 146 F.3d 1348, 1352 (Fed. Cir. 1998); *In re Gardner*, 475 F.2d 1389, 1391 (CCPA 1973).

Since original dependent claim 4, by law, necessarily contains both the switches recited in independent claim 1, and recited yet another, "single touch switch", originally filed claim 4 thus describes a three switch shredder. See *Benno, Id.*; *Hyatt, Id.*; *Gardner, Id.* Furthermore, and contrary to petitioner's contention, as claim 4 is part of the specification, see 35 U.S.C. § 112, second paragraph ("[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention,"), the specification can be fairly said to describe a 3 switch embodiment given that claim 4 does not expressly omit or preclude either or both of the paper touch switch and the disc touch switch, or expressly state that either or both of paper touch switch and the disc touch switch are replaced by the single touch switch, yet itself presents an additional, single touch switch whereby all input materials can all touch that touch switch. Thus, as drafted by applicant claim 4 recites a third switch that, while different in placement and operation from the other two touch switches, is capable of coexistence with the other 2 recited switches. Accordingly, the records of the USPTO do not clearly show the existence of a mistake in claim 4, much less a mistake incurred through the fault of the USPTO.

What the records of the USPTO do show is that, contrary to petitioner's urging, applicant never presented a claim limited to the one switch embodiment of the disclosure. However, that is not a USPTO caused error; that is applicant's error in claim drafting, which is not properly remedied under 35 U.S.C. § 254 and 37 CFR 1.322. See *In re Lambrech*, 202 USPQ 620 (Comm'r Pats. 1976); see also *Superior Fireplace Co. v. Majestic Products Co.*, 270 F.3d 1358, ____ (Fed. Cir. 2001) (noting for applicants "the critical importance of reviewing claims" before the allowed claims issue) (quoting *Southwest Software, Inc. v. Harlequin, Inc.*, 226 F.3d 1280, 1296 (Fed. Cir. 2000) ("it does not seem to us to be asking too much to expect a patentee to check a patent when it is issued in order to determine whether it contains any errors...") see also *Chef America Inc. v. Lamb-Weston Inc.*, 358 F.3d 1371, 1373 (Fed Cir. 2004) (quoting underlying district court decision, "[i]t is the job of the patentee, and not the court, to write patents carefully and consistently."). An example of the type of mistake typically covered by section 254 would be the circumstance that Petitioner had in fact presented a claim actually limited to the one switch embodiment, and that claim was allowed by the examiner, but it did not appear in the as-issued patent.

Moreover, as pointed out below, Petitioner essentially seeks to obtain through a certificate of correction a claim of a particular scope (a shredder with only one switch) which simply has never been evaluated on its merits by the Office. As made clear by the examiner's Reasons for Allowance, the examiner considered claims 1-4 patentable because the claims all required a paper touch switch and a disc touch switch (an interpretation that Petitioner did not dispute before the claims issued). If the Petitioner's request was granted, the Office would be issuing a broadened claim that it never considered, much less determined to be patentable, which is simply an illogical result. That type of error is not amenable to correction through section 254;

rather, reissue is the appropriate path to resolve Petitioner's claim drafting error, as was pointed out in the decision by the Certificates of Correction Branch. It is noted that Petitioner has in fact filed a reissue application which is currently pending.

Furthermore, petitioner appears to overlook section MPEP 608.01(I):

In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it. Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and description to show this subject matter. **The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim.** It is, of course, to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing and description (emphasis added).

Since claim 1 and 4 are both originally presented claims, the above-quoted section of the MPEP undercuts petitioner's contention that the examiner erred in not making some sort of objection to claim 4 and requiring it to be rewritten in independent form. This section of the MPEP further indicates that originally filed and patented claim 4 is not defective per se, and as noted above claim 4 is a proper dependent claim. That is, in view of the practice set forth in MPEP 608.01(I), the record does not "clearly disclose" any error that makes claim 4 eligible for correction under section 254.

Here, the patent was printed in accordance with the record in the Patent and Trademark Office of the application as passed to issue by the examiner. Claim 4 was passed to issue by the examiner exactly as it was drafted by applicant and presented on filing, and claim 4 was printed in the patent exactly as it was allowed by the examiner. Accordingly, assuming *arguendo*, there is a mistake in the patent, such was not "incurred through the fault of the Patent and Trademark Office" within the meaning of 35 U.S.C. § 254 and 37 CFR 1.322. Indeed, the applicant is bound by § 112, paragraph 4 to the same extent as the examiner. That is, any applicant has a clear duty to present claims that comply with § 112, paragraph 4 and provide adequate protection for his invention(s); he cannot neglect this duty and then be relieved of the consequences by claiming that the mistake is that of the USPTO in failing to notice and correct his error. *Lambrech*, at 621. The primary responsibility for presenting claims that provide adequate coverage for disclosed inventions rests with applicant. Applicant's failure to present a claim to the one switch embodiment is not correctable by way of 35 U.S.C. § 254 and 37 CFR 1.322. *Id.* Indeed, the *Michilin* court characterized this matter as a "drafting error by the patent applicant" as opposed to "an obvious administrative error" on the part of the USPTO, which is consistent with and reinforces the conclusion that petitioner is not entitled to a Certificate of Correction under § 254 and 37 CFR 1.322.

Ultimately, Petitioner's contentions boil down to the position that it should have been manifestly clear to the Office that claim 4 was intended to be an independent claim, and not a dependent claim, as was mistakenly drafted by the Petitioner. It is too much, however, to expect an examiner to be clairvoyant and read the mind of an applicant to understand that the applicant really wanted a claim that included the limitation recited in claim 4, and further included some, but not all, of the limitations recited in claim 1. Moreover, for the reasons stated above, it was entirely permissible for the examiner to understand original claim 4 as reciting an invention having an additional third switch. In fact, it is very clear from the format of claim 4 chosen by the applicant that the applicant sought claim 4 to be dependent on claim 1, rather than an independent claim. See, e.g., *Jeneric/Pentron, Inc. v. Dillon Co., Inc.*, 1999 WL 66537, *9 (D. Conn. 1999), *aff'd*, 205 F.3d 1377 (Fed. Cir. 2000) ("Claims can either be independent or dependent. An independent claim does not refer to any other claim of the patent and is read separately to determine its scope. . . . A dependent claim refers to at least one other claim of the patent, includes all of the limitations of the claim to which it refers, and specifies a further limitation on that claim."); see also 35 U.S.C. § 112, ¶¶ 3 and 4. Thus, since applicant drafted the claim and then did not respond to the examiner's Reasons for Allowance, Petitioner cannot reasonably expect that the claim can now be revised through a certificate of correction.

As to § 255 and its promulgating regulation, 37 CFR 1.323:

While petitioner has not specifically requested relief under 35 U.S.C. § 255 and 37 CFR 1.323, and Certificates of Correction Branch has not ruled on the matter, in the interests of economy for both petitioner and the USPTO, the USPTO will consider, *sua sponte*, the possibility of relief under this statute and its promulgating regulation. Cf. Lambrech, supra.

A Certificate of Correction under 35 U.S.C. § 255 and 37 CFR 1.323 is available only for the correction of errors of a minor or clerical character, and does not extend to the correction of errors that would constitute new matter or would require reexamination. See Superior Fireplace, supra; In re Arnott, 19 USPQ2d 1049, 1054 (Comm'r Pat. 1991); In re Hyman, 185 USPQ 441, 442 (Sol. Pat. 1975). Specifically, 35 U.S.C. § 255 requires, *inter alia*, that two specific and separate requirements be met prior to the issuance of a Certificate of Correction. The first requirement is that the mistake is: (1) of a clerical nature, (2) of a typographical nature, or (3) of minor character. The second requirement is that the correction must not involve changes that would: (1) constitute new matter or (2) require reexamination. See Arnott 19 USPQ2d at 1052; see also MPEP 1490. Petitioner's request fails on both counts to show that his failure to present a claim limited to the single switch embodiment during prosecution may now be remedied by a Certificate of Correction under § 255.

Specifically, it is not seen, and petitioner has not shown, that there is an error of a clerical nature, or of a typographical nature, or of minor character, present. What petitioner now proposes, in the guise of a Certificate of Correction is to present a claim to subject matter that was never examined by the examiner, was never passed to issue by the examiner, and was never given patent protection by the USPTO. Claim 1 presented a two switch embodiment and claim 4, by law, includes all the features—including both touch switches—of claim 1 *and* additionally recites an additional "single touch switch". The Examiner's Statement of Reasons for Allowance shows that the examiner considered all 4 claims as allowed to be inclusive of two touch switches. As the Federal Circuit observed in Superior at 1375: "[t]hus, Superior's suggestion that we compare claim scope by considering what was 'intended' by the parties, rather than by construing the claims for what they actually recite, is completely without merit." Thus, the single touch switch *only* embodiment was clearly not before the examiner, or passed to issue by the examiner. It follows that the proposed Certificate of Correction does not, contrary to petitioner's assertions, merely rewrite claim 4 in independent form. Rather, the proposed correction now specifically excludes the two touch switches of claim 1 that by operation of 35 U.S.C. § 112, paragraph 4, were specifically included in claim 4 as patented. The mistake in applicant's claim drafting is therefore, not of a clerical nature; not of a typographical nature; and not of minor character. Superior at 1376. Where, as here, the proposed correction broadens the scope of coverage of claim 4, and the alleged mistake in the claim is not clearly evident from the specification, drawings, and prosecution history, that is not a "mistake of a clerical or typographical nature" subject to correction under 35 U.S.C. § 255. Superior, *Id.* Moreover, a mistake the correction of which broadens a claim is not a "mistake of ... minor character" subject to correction under 35 U.S.C. § 255. *Id.* Furthermore, it clearly would require reexamination for the requested correction, as the "one touch switch" only embodiment was never claimed or examined during the pendency of the original application for patent, and was never issued by the USPTO. Petitioner's complaint that the decision of Certificate of Correction Branch failed to cite any authority for its refusal of a correction certificate, or its constructive suggestion to seek reissue, is answered by MPEP 1481⁴ which states in pertinent part:

37 CFR 1.323 relates to the issuance of Certificates of Correction for the correction of errors which were not the fault of the Office. Mistakes in a patent which are not correctable by Certificate of Correction may be correctable via filing a reissue application (see MPEP § 1401 - § 1460). See *Novo Industries, L.P. v. Micro Molds*

⁴See also case law and MPEP provisions discussed *infra*.

Corporation, 350 F.3d 1348, 69 USPQ2d 1128 (Fed. Cir. 2003) (The Federal Circuit stated that when Congress in 1952 defined USPTO authority to make corrections with prospective effect, it did not deny correction authority to the district courts. A court, however, can correct only if "(1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation...").

In re Arnott, 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991) specifies the criteria of 35 U.S.C. 255 (for a Certificate of Correction) as follows:

Two separate statutory requirements must be met before a Certificate of Correction for an applicant's mistake may issue. The first statutory requirement concerns the nature, i.e., type, of the mistake for which a correction is sought. The mistake must be:

- (1) of a clerical nature,
- (2) of a typographical nature, or
- (3) a mistake of minor character.

The second statutory requirement concerns the nature of the proposed correction. The correction must not involve changes which would:

- (1) constitute new matter or
- (2) require reexamination.

If the above criteria are not satisfied, then a Certificate of Correction for an applicant's mistake will not issue, and reissue must be employed as the vehicle to "correct" the patent. Usually, any mistake affecting claim scope must be corrected by reissue.

A mistake is not considered to be of the "minor" character required for the issuance of a Certificate of Correction if the requested change would materially affect the scope or meaning of the patent. See also MPEP § 1412.04 as to correction of inventorship via certificate of correction or reissue.

DECISION

For the reasons given above, the decision of Certificate of Correction Branch was proper in refusing the requested correction. The petition is granted to the extent that the decision of Certificate of Correction Branch has been reviewed, but is **denied** as to any modification thereof or issuance of a Certificate of Correction. While the requested correction will not be forthcoming under 35 U.S.C. § 254 or 255, petitioner may yet obtain relief under 35 U.S.C. § 251.

This decision may be considered a final agency action within the meaning of 5 U.S.C. § 704 for purposes of obtaining judicial review. See MPEP 1002.02. The USPTO will not further consider or reconsider this matter.

Any inquiries concerning this communication may be directed to the Petitions Examiner Brian Hearn at (571)272-3217.



Charles Pearson
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